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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,907	12/22/2000	Takahiro Endo	1344.1052 (JDH)	6594

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EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/741,907

Applicant(s)

ENDO ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-9,11,13-15,17,19-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1,2,4,6-9,11,13-15,17,19-23 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This office action is in response to the Request for Continued Examination filed December 27, 2006. Applicant amended claims 1, 6, 8, 9, 11, 13, 15, 17, 19 and 21-23, canceled claims 5, 12, 18 and 24 and added new claim 25. Claims 1, 2, 4, 6-9, 11, 13-15, 17, 19-23 and 25 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-9, 11, 13-15, 17, 19-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657).

Regarding claims 1, 2, 4, 6 and 7, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee; means for inputting a preference trend of addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient (addressee) creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for

selecting advertisements suitable for the preference trends of sender; means for making the card sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto also teaches sender selects a specific course; the sender can also receive a gift selected by the advertising company paying for this course, for example, a golf club manufacturer can have several golf-related gifts, and a car manufacturer can have several car-related gifts, an opportunity for soliciting ads (also called acceptance ads) which is a form of advertising (gift descriptions) that participants ask to see and show interest in (see also page 17). Sugimoto however failed to explicitly disclose wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the advertisement provider upon selection of the advertisement information. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria,

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preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target, which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).*

Regarding claims 8, 9, 11, 13 and 14, Sugimoto teaches means for sending card attached with optional message to specified addressee; means for inputting preference trends. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card means for selecting advertisement; means for presenting advertisement; selecting advertisement information suitable for the addressee; selecting advertisement information suitable for the sender; selecting and presenting plurality of advertisements; card sending client select one of the advertisement; a card sending history; changing additional information ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information_ (see pp. 16 lines 24-32 (par. 2), pp. 17 par. 2&3), and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses"

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by the sender (see page 17). Sugimoto however failed to explicitly disclose wherein the providing target (target audience or criteria) is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of an ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).

Claims 15, 17, 19 and 20 are rejected as stated above in claims 8-15.

Regarding claims 21-23, Sugimoto teaches sending a card attached with an optional message to a specified addressee; input preference trends of the addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting

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card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; selecting advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient filled out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein the providing target (target audience or target criteria or as indicated by applicant's argument "a target market") is preliminary determined by the advertisement provider. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more

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specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).*

Regarding claim 25, Sugimoto teaches inputting a preference trend of addressee (sender selecting specific course for selecting advertisement/gift, that he/she thinks the recipient (addressee) will like (see page 16)); preliminarily determining preference trends of a providing target of the advertisement by an advertisement provider. Sugimoto teaches selecting the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of “courses” by the sender (see page 17); selecting by advertisement provider advertisements suitable for the preference trends of addressee (based on the course selected by the sender, see page 17); selecting by card sending client at least one piece of advertisement from the plurality of advertisement displayed; (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto however failed to explicitly teach wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the advertisement provider upon selection of the advertisement information. Stanbach teaches the (target) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig.

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10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target which provides advertisements directed toward the recipient's more specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Sugimoto teaches changing additional information based on the number of time a card can be sent (see page 23). Sugimoto teaches the number of greeting cards can be limited ahead of time and can differ for different users or according to different classes of users (page 23).*

Based on Applicant's argument that the additional information is related to discount, Examiner presents the following rejection.

Claims 1, 2, 4, 6-9, 11, 13-15, 17, 19-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657) and further in view of Kamakura et al. (US 6,076,101).

Regarding claims 1, 2, 4-7, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee; means for inputting a preference trend of addressee. Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches means for

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inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for selecting advertisements suitable for the preference trends of sender; means for making the card sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3) and from the questionnaire the recipient fill out (see page 4) and based on the selection of "courses" by the sender (see page 17). Sugimoto does not specifically teach wherein a providing target (target audience or criteria) of the advertisement information, has been preliminarily determined by the advertisement provider upon selection of the advertisement information. Stanbach teaches the (*target*) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile (including client favorites such as hobbies (see col. 11 lines 10-22 and fig. 10 table 1064) of the intended recipient generated and advertisement matching the profile of the intended recipient is selected based on target audience (target age, target income, etc.) from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisements of Sugimoto, based on target criteria, preliminary selected by the advertiser for the purpose of narrowing the selection of the advertisement to the target, which provides advertisements directed toward the recipient's more

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specific demographic profile, as taught in Stanbach (see col. 12 lines 40-56). Sugimoto teaches selecting advertisement and displaying the advertisement and the sender selecting from the displayed advertisement at least one advertisement (see page 16 par. 2 and fig. 3). *Kamakura teaches changing additional information based on the number of time a card can is sent (see abstract, col. 3 lines 3-63). It would have been obvious to one of the ordinary skill in the art at the time of the invention to implement Kamadura's points in Sugimoto's email system, which provides predetermined points every time a recipient reads the message which increases the utilization frequency of the card sending service.*

Response to Arguments

Applicant's arguments filed December 27, 2006 have been fully considered but they are not persuasive. Applicant asserts that the additional information, i.e., a discount coupon ticket to be added to the card, may be changed based on the measured utilization frequency of the card. Examiner would like to point out that as claimed the additional information could be any information not just discount coupon ticket. As indicated above Sugimoto teaches changing additional information based on the utilization frequency.

Applicant also argues that neither Sugimoto nor Stanbach teaches or suggest, "wherein the plurality of advertisement information is selected so as to be suitable for the preference trends of the providing target for the selection. As indicated before, Stanbach teaches the advertisement provider determining the target audience, such as the target age, target sex, target income, for the advertisement, same as applicants invention (see col. 12 lines 39-55). Stanbach teaches "[a]fter receiving an e-mail message from a mail agent or other means, the system extracts the intended recipient information from an e-mail message header. A demographic

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profile of the intended recipient is generated (or selected, as the information already exists). Next, a set of advertisements matching the demographic profile of the intended recipient is selected from a table of advertisements. The contents of an e-mail message body are used to form a query to apply to a set of advertisements matching the demographic profile of the intended recipient. Next, the query is applied to the set of selected advertisements, and an advertisement (or possibly a set of advertisements) is selected and associated with the e-mail message. Ultimately, the advertisement is presented to the intended recipient, by either inserting the advertisement into the e-mail message body, or attaching the advertisement to the e-mail message, or inserting the advertisement in or attaching the advertisement to a subsequent e-mail or other message transmitted to the intended recipient at a later time. Therefore, selecting advertisements matching the demographic profile indicates that the target (the ones that match the demographic profile) has been preliminary determined. Sugimoto also teaches sender selects a specific course; the sender can also receive a gift selected by the advertising company paying for this course, for example, a golf club manufacturer can have several golf-related gifts, and a car manufacturer can have several car-related gifts, an opportunity for soliciting ads (also called acceptance ads) which is a form of advertising (gift descriptions) that participants ask to see and show interest in (see also page 17).

Applicant also argues that neither Sugimoto nor Stanbach discloses “selecting a plurality of advertisement information suitable for the preference trends of the addressee. As indicated before, Sugimoto teaches requesting the recipient to fill out a questionnaire before the recipient creates the first greeting card and displaying a keyword advertisement created for the sender according to the answers to the questionnaire by the recipient (see page 4). Sugimoto teaches

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means for inputting a preference trends of sender (sender selecting specific course for selecting advertisement/gift); means for adding advertisement selected to the card; selecting advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Stanbach also teaches the demographic profile including user lifestyle preference and favorites (see col. 11 lines 10-22, col. 19 lines 4-14 and figure 10 table 1064) and the advertisement selected based on the preference (lifestyle preference and favorites) of the recipient (addressee).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTA YEHDEGA
PRIMARY EXAMINER